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PARSONS BEHLE & LATIMER


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DATE: 11-05-01		PAYEE: COMMISSIONER OF PATENTS AND		VENDOR #: 2203	CHECK #: 156289
YOUR INV. #	INV. DATE	INV. AMOUNT	DESCRIPTION	AMOUNT PAID	
110501H	11-05-01	1,735.00	PTO FEE	1,735.00	
			Basic Filing Fee	\$	370.00
			Fee for Claims In Excess of Twenty (87 X \$9.00)		783.00
			Fee for Independent Claims over Three (11 X \$40.00)		462.00
			Surcharge for Late Filing of Declaration		65.00
			Fee for One Month's Extension of Time		55.00
			TOTAL	\$	1,735.00
Applicants: Bill J. Pope, et al.					
Serial Number: 09/840,623					
Title: Methods for Making Bearings, Races and Components Thereof Having Diamond and Other Superhard Surfaces 50-0581					
Attorney's Docket Number: 05261..032/6069.1 P					

PLEASE STAMP TO ACKNOWLEDGE RECEIPT OF THE FOLLOWING:

In re Patent Application of: Bill J. Pope, et al.

Serial Number: 09/840,623

Examiner: Unassigned

Filing Date: April 22, 2001

Group Art Unit: 3682

Title: METHODS FOR MAKING BEARINGS, RACES AND COMPONENTS
THEREOF HAVING DIAMOND AND OTHER SUPERHARD
SURFACES

Papers filed:

1. Response to Notice to File Missing Parts;
2. Certificate of Mailing signed and dated November 28, 2001;
3. Copy of Notice to File Missing Parts of NonProvisional Application;
4. Declaration for Patent Application signed by all inventors;
5. Petition for Extension of Time for One Month;
6. Certificate of Mailing signed and dated November 28, 2001;
7. Change of Attorney's Address signed and dated November 28, 2001;
8. Appointment of Associate Attorney signed and dated November 28, 2001;
9. Check Number 156289 in the amount of \$1,735.00.

Docket No.: 05261.032/6069.1 P

Dated: 11-28-01

Attorney: Daniel P. McCarthy

RRC:ipn412



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,623	04/22/2001	Bill J. Pope	6069.1 P	3960

7590 02/10/2003

McCarthy & Sadler, LC
Suite 100
39 Exchange Place
Salt Lake City, UT 84111

EXAMINER

NGUYEN, TRINH T

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 02/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

APR 02 2010

Office Action Summary	Application No.	Applicant(s)	
	09/840,623	POPE ET AL.	
	Examiner	Art Unit	
	Trinh T Nguyen	3726	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-107 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-107 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Application/Control Number: 09/840,623
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DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1: A method for manufacturing a bearing unit component as directed to claims 1-101, and 103-107.

Species 2: A method for manufacturing a bearing unit component as directed to claim 102.

2. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there is no generic claim.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

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are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Note that the numbering of claims is incorrect (i.e., there are two claims 67). For the purpose of this Office Action, the misnumbered claims 1-104 (as originally claimed) have been renumbered* claims 1-107.
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trinh T Nguyen whose telephone number is (703) 306-9082. The examiner can normally be reached on M-F (9:30 A.M to 6:00 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich can be reached on (703) 308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

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Art Unit: 3726

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ttn
January 29, 2003.

J. C. A. R. L.
Art 3726

PLEASE STAMP TO ACKNOWLEDGE RECEIPT OF THE FOLLOWING:

In re U. S. Patent Application of: Bill J. Pope, et al.

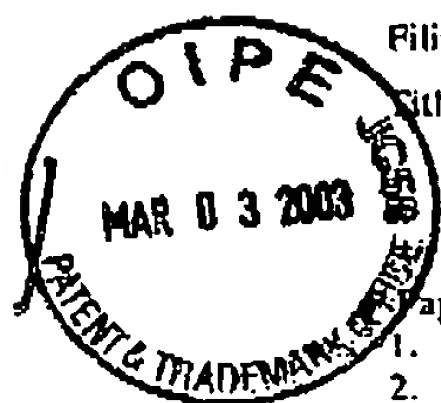
Serial Number: 09/840,623

Examiner: Trinh T. Nguyen

Filing Date: April 22, 2001

Group Art Unit: 3726

Title: "METHODS FOR MAKING BEARINGS, RACES AND COMPONENTS
THEREOF HAVING DIAMOND AND OTHER SUPERHARD
SURFACES"



Papers filed:

1. Response to Office Action signed and dated February 26, 2003;
2. Certificate of Mailing signed and dated February 26, 2003;
3. Information Disclosure Statement signed and dated February 26, 2003, and accompanied by Form 1449 and copies of cited patents;
4. Certificate of Mailing signed and dated February 26, 2003.

Docket Number: 05261.032/6069.1

Dated: 02-26-03

RRC:ipn752

Attorney: Daniel P. McCarthy